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EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/538,466

Applicant(s)

WHITE, DANIEL F

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/05/2004 has been entered.

Response to Amendment

2. The Applicant's amendment B, paper#10, received on 1/5/2004 is acknowledged and entered. Claims 7, 9, 11, 12, 13, 14, 16, 18, 19, 20, 21, 22, and 23 are amended. Currently claims 7-24 are pending for examination.

Response to Arguments

3.1. Applicant's arguments with respect to newly amended claims 7-24 have been considered but are moot in view of the new ground(s) of rejection.

3.2. Applicant's arguments (see amendment B, page 10-12) filed concerning claim 7 on 01/05/2004 have been fully considered but they are not persuasive for following reasons:

(a) The applicant's arguments (see amendment B, page 10) related to the combination of Walker/Miller reference is not relevant as the examiner did not use

Walker/Miller reference to reject claim 7 in the earlier office action. The Examiner's arguments submitted related to Walker/Miller were directed to claims 1-6, which are already cancelled.

(b) Miller's driver check-out station including a barcode reader is fully capable to read an assigned order number in the form of barcode whether it is on a generated label attached to a package or on a print-out with the customer (see col.6, line 61-col.7, line 5) who has come to pick up the package so that it can be verified that both the order numbers are same.

(c) The limitation , " *retrieving the assigned order number from the storage unit coupled to the computer* ", (see amendment B, pages 10-11) recited in the newly amended claim 7 is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither the applicant has disclosed support for this newly amended limitation nor the examiner, after studying the applicant's disclosure, could find support for the same. The specification teaches that the assigned order number is presented by the buyer himself (see specification, page 8, lines 11-13, page 9, lines 12-13) or it is transmitted by a PDA via Internet (see specification page 10, lines 5-9).

(d) The applicant argues that the references Cupps or Miller do not disclose receiving an assigned order number over a public access network and storing the same for verification when picking up a package (see Amendment B, page 11). The claim 7 is a system claim and the limitation is directed to a computer which is capable of receiving an assigned order number over a public access network and storing the same which in fact are same as receiving data and storing the same. In Cupps, the client computer 102 including a memory 119 (see at least col.3, line 49-col.4, line 12, col.9, lines 35-47,

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col.11, lines 20-27) is capable of both receiving data from a server over the public access network, such as Internet, and storing that data regardless whether that data is an order number or some other text/image. Also see MPEP 2114 which specifies that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case all the features and knowledge that have been used to reject the claim either exist in the references or only that knowledge has been used which was within the level of ordinary skill at the time the claimed invention was made, as analyzed above.

3.3. Regarding the applicant's arguments concerning method claim 16 they are also analyzed and discussed on the same basis as for claim 7, except for the following additional issues :

Cupps teaches receiving an assigned order number over the public access network (see at least col.8, lines 24-40, and col.10, lines 22-25, wherein Cupps discloses transmitting an order text file to a vendor by telephone or fax and these modes correspond to public-access network. The text –file, as detailed in FIG.6 also includes the assigned order number and other information about the order. Cupps also teaches storing the assigned order number (see at least col.10, lines 32-42, wherein the order text file 138 including the assigned order is recorded into a database for the vendors to hear the recorded message. Recording the assigned order number corresponds to storing the assigned order number received on a telephone line, which is a public-access network. *Note: The claim limitation does not specifically recite as where this assigned order number is stored, it only recites storing the assigned order number.*

3.4. Regarding claims 8 and 17, the applicant's arguments are not persuasive in view of the analysis for claims 7 and 16 made above. Further, the applicant has neither traversed the facts and benefits of the Official Notice, taken by the examiner, adequately nor asked for a documentary evidence. Therefore, as per *MPEP-2144.03 [R-1] C Reliance on Common Knowledge in the Art or "Well Known" Prior Art* -, the common knowledge or well-known fact considered as Official Notice in the art statement is taken to be admitted prior art .

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case all the features and knowledge that have been used to reject the claim either exist in the references or only that knowledge has been used which was within the level of ordinary skill at the time the claimed invention was made, as analyzed above.

3.5. Regarding claims 9 and 18, the applicant's arguments are not persuasive in view of the analysis for claims 7 and 16 made above. Also, like in claims 7 and 16 the newly amended claims 9 and 18 recite the limitation, " *automated check-out station readsto retrieve the assigned order number....*" , which is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither the applicant has disclosed support for this newly amended limitation nor the examiner, after studying the applicant's disclosure, could find support for the same. The specification teaches that the assigned order number is presented by the buyer himself (see specification, page 8, lines 11-13, page 9, lines 12-13) or it is transmitted by a PDA via Internet (see specification page 10, lines 5-9).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case all the features and knowledge that have been used to reject the claim either exist in the references or only that knowledge has been used which was

within the level of ordinary skill at the time the claimed invention was made, as analyzed above.

3.6. Applicant's arguments, see amendment B, pages 13-14, filed 01/05/2004, with respect to the rejection(s) of claim(s) 14-15 and 23-24 under 35 U.S.C. 103 (a) as being unpatentable over Cupps, and further in view of Miller have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Espada-Velasco (US Patent 5,802,890).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case all the features and knowledge that have been used to reject the claim either exist in the references or only that knowledge has been used which was within the level of ordinary skill at the time the claimed invention was made, as analyzed above.

3.7. Regarding claims 10-11 and 19-20, the applicant's arguments are not persuasive in view of the analysis for claims 7 and 16 made above. Further, the applicant's argument that Cupp's computer cannot be replaced by Suzuki's PDA is not substantive. Cupps discloses use of any type of computing device including portable computer in the form of laptop (see at least col.3, lines 63-67) and Suzuki explicitly discloses use of a computing device in the same field of electronic commerce of issuing messages/data

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and receiving data/messages (see at least col.9, line 56-col.10, line 18). Irrespective of the type of computing device, that is, desktop computer, or laptop computer or PDA all are capable of issuing and receiving orders/messages/data. In view of Suzuki, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have modified Cupps to use PDA, because it helps desktop computer, Whether data includes orders or any other text messages replacing the Cupps' computing device by Suzuki's PDA, which is also a computing device

Also, like in claims 7 and 16 the newly amended claims 11 and 19-20 recite the limitation, "*and retrieved from the stored-value card by the automated check-out station*", "*...from the PDA and determining whether the retrieved assigned order number corresponds to for the generated label identifying the assigned order number*", and "*so that the assigned order number may be retrieved from the stored-value card for verification*", which are not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither the applicant has disclosed support for this newly amended limitation nor the examiner, after studying the applicant's disclosure, could find support for the same. The specification teaches that the assigned order number is presented by the buyer himself (see specification, page 8, lines 11-13, page 9, lines 12-13) or it is transmitted by a PDA via Internet (see specification page 10, lines 5-9).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case all the features and knowledge that have been used to reject the claim either exist in the references or only that knowledge has been used which was within the level of ordinary skill at the time the claimed invention was made, as analyzed above.

3.8. With reference to the applicant's arguments presented concerning claims 12 and 21 (see amendment page 16), the examiner respectfully disagrees for the following reasons:

(a) In response to applicant's argument that " Instead, Suzuki teaches the transmission of transaction data to the kiosk for storage on the ID card.....Suzuki, therefore, is reversal of Applicant's invention.....", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

(b) Claim 12 is a dependency of claim 7 and recite the limitation, " the permanent identification number being transmitted over the public access network to the cafeteria web site for use as the assigned order number " on page 4 of the amendment. However, claim 7 already recites the limitation that it is the function of the cafeteria web site to issue the assigned order number and transmit it to the computer. When the limitations of claim 7 are included in the claim 12 the invention becomes indefinite and unclear as what is the need of providing an other assigned order number when it is already provided by the cafeteria web site. The invention becomes confusing as why there should be two assigned order numbers and how are they related. Therefore claim 12 is rejected under second paragraph of 35 U.S.C. 112. For similar reasons claim 21 is rejected under second paragraph of 35 U.S.C. 112.

(c) Suzuki clearly teaches the limitations recited in claims 12 and 21, that is " a card reader coupled to the computer, the card reader for reading a stored-value card having a permanent identification number (see at least col.7, lines 10-18, " A *customer might insert the ID card into an ID card reader/writer unit provided at the kiosk terminal, and access the kiosk terminal's merchandise inventory database in order to select items for purchase* " .Note: The ID card corresponds to the stored value card and the kiosk to a computer as claimed). Suzuki further teaches transmitting the permanent identification number of the card to a website for use because whenever the card is used by insering in a coputer (kiosk in Suzuki) transmits the customer identification data including a customer ID in the form of permanent identification number (see at least Fig.2 and col.10, lines 27-57) for the retail facility to identify and verify the particular transactions with corresponding customers which corresponds to the intended function of using the ID number as assigned order number to correlate the customer who placed the order The retail facility's server corresponds to the cafeteria website. Also, it is to be noted that the intended use of the ID number to be used as the assigned order number is not functionally integrated with the claimed step of transmitting the ID number. Therefore, the intended functions as using the ID number as the assigned order or to verify and correlate transactions with specific customers are non-fuctional descriptive material. Regardless of the fact whether the ID number is to be used to correlate and verify transactions with specific customers as in Suzuki or to be used as the assigned order number the step of transmitting the ID number is implemented. However these differences are only found in the *nonfunctional descriptive material* and are not *functionally* involved in the steps recited. The transmitting step would be performed the same regardless of the *data*. Thus, this *non-functional descriptive material* will not distinguish the claimed invention from the prior art in terms of patentability, see In re

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Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the ID number of the card to to correlate and verify transactions with specific customers as in Suzuki or to be used as the assigned order number, because such *data* does not *functionally* relate to the steps claimed and because the subjective interpretation of the *data* does not patentably distinguish the claimed invention.

As per the newly amended limitation the ID number is transmitted over the public-access network. Suzuki discloses that any commercially available communication technology, (see at least col.9, lines 39-55) and that covers the claimed public-access network the use of which is already demonstrated in Cupps/Miller reference which has been used to reject the claims 7 and 16 on which claims 12 and 21 depend.

The motivation to combine Suzuki with Cupps/Mille as applied to claims 7 and 16 is already submitted in the earlier office action and reproduced here: Doing so would enable the customers to record and store information in a portable device like a smart card, irrespective of the type of information whether it is related to a merchandize or an order number and for reading the same to correlate the merchandises to be picked up at the checkout station and helps to eliminate the need for printers and printouts and to make the shopping experience economical, efficient and convenient. Incidentally, the applicant has not traversed this motivation submitted in the earlier office action.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does

not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case all the features and knowledge that have been used to reject the claim either exist in the references or only that knowledge has been used which was within the level of ordinary skill at the time the claimed invention was made, as analyzed above.

3.9. Regarding claims 13 and 22, the applicant's arguments are not persuasive in view of the analysis for claims 7, 11, 16 and 22 made above. Also, like in claims 7 and 16 the newly amended claims 13 and 22 recite the limitation, " deducts an amount corresponding to the prepared order verified as having an assigned order number on its generated label that corresponds to the assigned order number retrieved from the stored value card....", which is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither the applicant has disclosed support for this newly amended limitation nor the examiner, after studying the applicant's disclosure, could find support for the same. The specification teaches that the assigned order number is presented by the buyer himself (see specification, page 8, lines 11-13, page 9, lines 12-13) or it is transmitted by a PDA via Internet (see specification page 10, lines 5-9).

Claim Rejections - 35 USC § 112

4.0 The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled

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in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 7, 16, & 19 contain subject matter, " an automated check-out station retrieving the assigned order number from the storage unit of the computer ", claims 9 & 18 contain subject matter, "an automated check-out station retrieving the assigned order number from the printed bar code ", claims 11, 13, 20, & 22 contains subject matter, "an automated check-out station retrieving the assigned order number from the stored-value card ", which are not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither the applicant has disclosed support for this newly amended limitation nor the examiner, after studying the applicant's disclosure, could find support for the same.

Claims 8, 10, 12, 14, 15, 17, 21, and 23-24 are dependencies of claims 7, and 16 and therefore they are also rejected for the same reasons.

Since examiner has not found any support for these newly added limitations the examiner has interpreted these amendments, in view of the applicant's disclosure, as follows and all these claims will be further treated on merits accordingly :

For claims 7, 16, & 19----automated check-out station receiving the assigned order number for verifying ----

For claims 9 and 18---automated check-out station reads the printout of the bar code---

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For claims 11, 13, 20, and 22- automated check-out station receiving the assigned order number for verifying—. Since this limitation is already included in claims 7 and 16 on which claims 11, 13, 20, and 22 depend there is no need to include it in these dependent claims.

4.1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is a dependency of claim 7 and recite the limitation, " the permanent identification number being transmitted over the public access network to the cafeteria web site for use as the assigned order number " on page 4 of the amendment. However, claim 7 already recites the limitation that it is the function of the cafeteria web site to issue the assigned order number and transmit it to the computer. When the limitations of claim 7 are included in the claim 12 the invention becomes indefinite and unclear as what is the need of providing an other assigned order number when it is already provided by the cafeteria web site. The invention becomes confusing as why there should be two assigned order numbers and how are they related.

For similar reasons claim 21 is rejected under second paragraph of 35 U.S.C. 112.

As best understood by the examiner the limitation " the permanent identification number being transmitted over the public access network to the cafeteria web site for use as the assigned order number " is not being given a patentable weight in claims 12 and 21 while further treating them on merits.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.1. Claims 7, 9, 16, and 18, and are rejected under 35 U.S.C. 103(a) as being unpatentable over Cupps, and further in view of Miller.

Regarding claim 7, Cupps teaches an automated cafeteria (see at least Fig.9 a web page for automated Pizza delivery restaurant), comprising:

a cafeteria web site for presenting a menu over a public-access network and for assigning an order number to an order comprised of menu selections

(see at least FIGs.9, 10, which show "Enzo's Pizza" web site presenting delivery menu, FIG.11, boxes 306, 308, and 309 which shows that a customer is able to place an order for pizza after seeing online menu on web pages and the same order is received by an online ordering machine to process the order. The online ordering machine corresponds to the web site of the automated cafeteria. Also see FIGs 12A-12C and col.2, lines 19- 50, col.8, line 41-col.10, line 10. Also see col.10, lines 23-26 and FIG.6, "...Referring to FIG.13, an entry is generated for the order in the order database 128 [step 312]. An order text file 138 is generatedin accordance with a prescribed format as shown in FIG.6 [step 314]. The prescribed format of the order includes an order number [see FIG.6].) ;

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a computer for issuing an order message and for receiving the assigned order number over the public-access network (see FIG.1 and FIG.2. Client computer 102A....102N. Client computer enables the viewing of the menu and receipt of the order data [see FIG.6] which includes assigned order number. The claim 7 is a system claim and the limitation is directed to a computer capable of receiving an assigned order number over a public access network and storing the same which in fact are same as receiving data and storing the same. In Cupps, the client computer 102 including a memory 119 (see at least col.3, line 49-col.4, line 12, col.9, lines 35-47, col.11, lines 20-27) is capable of both receiving data from a server over the public access network, such as Internet, and storing that data regardless whether that data is an order number or some other text/image. Also see MPEP 2114 which specifies that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

"[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original) ;

a storage unit for the assigned order number that is coupled to the computer (see at least FIG. 2, " 119 memory" and col.4, lines 1-12, "...FIG.2 illustrates the client computer 102....a memory 119...The memory 119 can contain the following....Internet access procedures 122; as well as other procedures and files ". Note: the memory 119 can store the order text file which includes the assigned order number);

Cupps does not disclose the following:

a label generator for receiving the assigned order number from the cafeteria web site and generating a label identifying the assigned order number for a corresponding prepared order, the label being associated with the corresponding prepared order.

However, in the same field of endeavor of receiving food orders via communication network, Miller teaches a label generator for receiving the assigned order number from the cafeteria web site and generating a label identifying the assigned order number for a corresponding prepared order (see at least col.4, lines 34-47, " an employee 10 receives a phone order.....If as an option the customer may pick up an order...", col.5, lines 13-155, "... Entry of an order....produce a printed bar code label 30 such as indicated in FIG.7. The bar code label 30 may have zones 31-40 for receiving order data...A bar code at zone 40 may represent an order number [such as 3465] assigned to the order by the system...an individual bar code label may be printed out by a bar code printer.....").

In view of Miller, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to modify Cupps to include the disclosed feature of generating a label with information of the order received from the customer such as assigned order number for the obvious reason to track and identify the orders before being picked up at checkout station for home delivery to check if all the items of the order are included in the delivery to the customer, as explicitly disclosed in Miller (col.6, line 61-col.7, line 5, "... The label segment of FIG.7 or FIG.8 may be adhesively backed.....The driver checking out station 70 may include an instant bar code reader e.g. at a fixed location 82 for reading the bar code representing the order identification number [e.g. number 2072, FIG.8] ").

Cupps also does not also disclose the following:

an automated check-out station for receiving an assigned order number and for verifying that the received assigned order number corresponds to the assigned order number on the generated label for a prepared order presented to the automated check-

out station so that the prepared order may be obtained at the automated check-out counter.

However, in the same field of endeavor of receiving food orders via communication network, Miller teaches an automated check-out station for receiving an assigned order number and for verifying that the received assigned order number corresponds to the assigned order number on the generated label for a prepared order presented to the automated check-out station so that the prepared order may be obtained at the automated check-out counter (see at least col.4, lines 34-47, " an employee 10 receives a phone order.....If as an option the customer may pick up an order...", col.6, line 61-col.7, line 5, "...The label segment of FIG.7 or FIG.8 may be adhesively backed.....The driver checking out station 70 may include an instant bar code reader e.g. at a fixed location 82 for reading the bar code representing the order identification number [e.g. number 2072, FIG.8] ". Note: The driver check-out station 70 corresponds to the automated check-out station where the bar code label is checked, identified and verified. In order to identify and verify the order it would be inherent in the system that the bar code reader at the check-out station 70 would have received the assigned order number to verify and identify the order number included on the label.).

In view of Miller, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to modify Cupps to include the disclosed feature of receiving an assigned order number and for verifying that the received assigned order number corresponds to the assigned order number on the generated label for a prepared order presented to the automated check-out station so that the prepared order may be obtained at the automated check-out counter for the obvious reason to economically and efficiently track, verify and identify the orders automatically, without the need of human operators to do identifying, verifying the order information on

the label of the food package before being picked up at checkout station for home delivery to check if all the items of the order are included in the delivery to the customer, as explicitly disclosed in Miller (col.6, line 61-col.7, line 5, "... The label segment of FIG.7 or FIG.8 may be adhesively backed..... The driver checking out station 70 may include an instant bar code reader e.g. at a fixed location 82 for reading the bar code representing the order identification number [e.g. number 2072, FIG.8] ").

Regarding claim 9, Cupps/Miller teaches a system for ordering on a web site of an automated cafeteria and correlating the assigned order as disclosed and analyzed in claim 7 above. Cupps does not disclose the following:

That the storage unit for the assigned order is a printout of a bar code corresponding to the order number; and the automated check-out station reads the printout of the bar code and verifies the assigned order number by determining whether the printout of the bar code corresponds to the assigned order number.

However, in the same field of endeavor of receiving food orders via communication network, Miller teaches that the storage unit for the assigned order is a printout of a bar code corresponding to the order number; and the automated check-out station reads the printout of the bar code and verifies the assigned order number by determining whether the printout of the bar code corresponds to the assigned order number (see at least col.1, lines 15-55, "...Entry of an order....produce a printed bar code label 30 such as indicated in FIG.7. The bar code label 30 may have zones 31-40 for receiving order data...A bar code at zone 40 may represent an order number [such as 3465] assigned to the order by the system...an individual bar code label may be printed out by a bar code printer.....", col.6, line 61-col.7, line 5, "... The label segment of FIG.7 or FIG.8 may be adhesively backed..... The driver checking out station 70 may

include an instant bar code reader e.g. at a fixed location 82 for reading the bar code representing the order identification number [e.g. number 2072, FIG.8] ". Note: The driver check-out station 70 corresponds to the automated check-out station where the bar code label is checked, identified and verified. In order to identify and verify the order it would be inherent in the system that the bar code reader at the check-out station 70 would have received the assigned order number to verify and identify the order number included on the label.).).

In view of Miller, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to modify Cupps to include the feature of storing the assigned order in a printout of a bar code corresponding to the order number; and the automated check-out station reads the printout of the bar code and verifies the assigned order number by determining whether the printout of the bar code corresponds to the assigned order number. Doing so would enable the system to prevent mix-ups involving the identity of the delivery person or pick up person responsible for the order as explicitly disclosed in Miller (col.1, lines 60- 62 and) and further enables the delivery drivers to check if they have included all the ordered items for delivery.

Regarding claims 16, and 18, all limitations are covered in claims 7, and 9 respectively and are therefore analyzed and rejected as unpatentable over Cupps and further in view of Miller on the basis of same rationale.

5.2. Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being obvious over Cupps/Miller as applied to claims 7 and 16 above, in view of Official Notice.

Regarding claim 8, Cupps/Miller teaches a system for ordering on a web site of an automated cafeteria and correlating the assigned order as disclosed and analyzed in claim 7 above. Cupps/Miller does not disclose:

the storage unit for the assigned order number is a printout of the order number.

Official Notice is taken of the concept and benefits of storing the assigned order number in a printout. It is old and well known to print copies of transactions executed online including order confirmations, payment confirmations, etc. for the obvious reason of referring to them in future as a proof of transaction or for receipt of an online order at the time of pick up of a merchandise. In view of the Official Notice, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to use a printout to store the assigned order number for later using it as a proof to collect the order.

Regarding claim 17, limitations are covered in claim 8 and are therefore analyzed and rejected as being obvious over Cupps/Miller and in further view of Official Notice on the basis of same rationale.

5.3. Claims 10-13 and 19-22 are rejected under 35 U.S.C. 103(a) as Being obvious over Cupps/Miller as applied to claims 7 and 16 above, and further in view of Suzuki (US Patent 6,129,274).

Regarding claims 10, Cupps/Miller teaches a system for ordering on a web site of an automated cafeteria and correlating the assigned order as disclosed and analyzed in claim 7 above. Cupps/Miller does not disclose the following:

the computer is a personal digital assistant (PDA) and the storage unit for the assigned order number is internal to the PDA.

However, in the same field of endeavor i.e. electronic commerce, Suzuki teaches that the computer is a personal digital assistant (PDA) and the storage unit for the assigned order number is internal to the PDA (see at least col.9, line 56-col.10, line 18, "...The personal digital assistant 10 is preferably configured as a smart card-like IC card, which provides a suitable means for a customer to transport pertinent data between terminal locationsand exchange pertinent data...through the use of various interface units.....the customer card 10 comprises a personal memory card....suitably comprises a central processor unit [CPU] 50.....in combination with a memory store 52.....card further includes an input/output interface circuit 54 by which information is read to and written from the memory store 52....". Note: The PDA used in Suzuki allows to record and store information in the PDA and the same information can be read later to correlate and verify merchandises as demonstrated by Suzuki to help the customers to shop in a retail store without having to carry the purchases with them as they move from department to department. Details of the purchases are recorded in the PDA and when a customer terminates his/her shopping session the POS terminal is able to read the transaction details from the PDA and transmits the list of items purchased to the stock room from where the merchandise can be picked up (see at least col.7, line 58-col.8, line 14).

In view of Suzuki, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Cupps/Miller to incorporate the feature of using a personal digital assistant (PDA) and the storage unit for the assigned order number is internal to the PDA because it enables the customers to record and store information, irrespective of the type of information whether it is related to a merchandise or an order number and for reading the same to correlate the merchandises to be picked

up at the checkout station. This ability helps to eliminate the need for printers and printouts and to make the shopping experience economical, efficient and convenient.

Regarding claim 11, Cuppa/Miller teaches a system for ordering on a web site of an automated cafeteria and correlating the assigned order as disclosed and analyzed in claim 7 above. Cupps/Miller does not disclose:

a card reader coupled to the computer; and
the storage unit is a stored-value card so that an assigned order number transmitted to the computer from the cafeteria web site may be stored by the card reader in the stored-value card.

Note: Claim 11 is being further treated on merits as interpreted above while rejecting it under USC 112 first paragraph.

However, in the same field of endeavor i.e. electronic commerce, Suzuki teaches a card reader coupled to the computer (see at least col.7, lines 14-18, "...A customer might insert the ID card into an ID card reader/writer unit provided at the kiosk terminal...". Note: Kiosk terminal corresponds to a computer) and the storage unit is a stored-value card so that an assigned order number transmitted to the computer from the cafeteria web site may be stored by the card reader in the stored-value card (see at least col.7, lines 18-20, "...As a customer selects various items for purchase, the kiosk terminal is able to write the information.....to the customer's ID card..." and col.9, line 56-col.10, line 18, "....The personal digital assistant 10 is preferably configured as a smart card-like IC card, which provides a suitable means for a customer to transport pertinent data between terminal locationsand exchange pertinent data...through the use of various interface units.....the customer card 10 comprises a personal memory card....suitably comprises a central processor unit [CPU] 50.....in combination with a

memory store 52.....card further includes an input/output interface circuit 54 by which information is read to and written from the memory store 52.....". Note: The PDA used in Suzuki allows to record and store information in the PDA and the same information can be read later to correlate and verify merchandises as demonstrated by Suzuki to help the customers to shop in a retail store without having to carry the purchases with them as they move from department to department. Details of the purchases are recorded in the PDA and when a customer terminates his/her shopping session the POS terminal is able to read the transaction details from the PDA and transmits the list of items purchased to the stock room from where the merchandise can be picked up (see at least col.7, line 58-col.8, line 14).

The claim 11 is a system claim dependent on claim 7 and the limitation is directed to a storage unit which is a stored value card capable of storing an assigned order number transmitted to the computer recited in claim 7 over a public access network. In Suzuki, the smart IC-card also is capable of both receiving data from a server over the public access network, such as Internet, and storing that data regardless whether that data is an order number or some other text/image. Also see MPEP 2114 which specifies that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original)

In view of Suzuki, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Cupps/Miller to incorporate the feature of a card reader coupled to the computer and the storage unit is a stored-value card so that an assigned order number transmitted to the computer from the cafeteria web site may

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be stored by the card reader in the stored-value card. Doing so would enable the customers to record and store information in a portable device like a smart card, irrespective of the type of information whether it is related to a merchandise or an order number and for reading the same to correlate the merchandises to be picked up at the checkout station and helps to eliminate the need for printers and printouts and to make the shopping experience economical, efficient and convenient.

Regarding claim 12, Cupps/Miller teaches a system for ordering on a web site of an automated cafeteria, receiving the assigned order number over the public-access network and correlating the assigned order as disclosed and analyzed in claim 7 above.

Note: Claim 12 is being further treated on merits as interpreted above while rejecting it under USC 112 second paragraph.

Cupps/Miller does not disclose:

a card reader coupled to the computer, the card reader for reading a stored-value card having a permanent identification number; However, in the same field of endeavor i.e. electronic commerce, Suzuki teaches a card reader coupled to the computer, the card reader for reading a stored-value card having a permanent identification number; (see at least col.7, lines 14-18, "...A customer might insert the ID card into an ID card reader/writer unit provided at the kiosk terminal...", col.7, Note: Kiosk terminal corresponds to a computer and information on incentives/loyalty points corresponds to the stored value on the card, col.3, lines 17-38 discloses issuing a smart pre-paid guest card to identify the rightful cardholder and enable him to receive the appropriate services and/or products at the respective services/products terminals. This feature of verifying the identity of the right cardholder from the paid guest card at the services/product terminal will inherently include a card reader coupled to the terminal to read the

identification number on the card and to transmit the identity information to the theme parks computer system to correlate with the already registered identification number to validate the use of services/products that are already pre-paid for.).

In view of Suzuki, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Cupps/Miller to incorporate the feature of a card reader coupled to the computer, the card reader for reading a stored-value card having a permanent identification number because it provides efficient and convenient personalized shopping assistance by allowing the customer not to carry any cash or additional printed receipts to authorize him to use the product/services already pre-paid for, as explicitly disclosed in Suzuki (col.3, lines 17-39).

Regarding claim 13, Cupps/Miller teaches a system for ordering on a web site of an automated cafeteria and correlating the assigned order as disclosed and analyzed in claim 7 above.

Note: Claim 13 is being further treated on merits as interpreted above while rejecting it under USC 112 first paragraph.

Cupps/Miller does not disclose:

the check-out station deducts an amount corresponding to the prepared order identified by the assigned order number from an added-value card.

However, in the same field of endeavor i.e. electronic commerce, Suzuki teaches that the check-out station deducts an amount corresponding to the prepared order identified by the assigned order number from an added-value card (see at least col.3, lines 17-38 which discloses issuing a smart pre-paid guest card to be also used as a debit system. This smart card identifies the rightful cardholder and enables him to receive the appropriate services and/or products that have been paid for and written into

the memory store of the card at the respective services/products terminals. The service/product terminals correspond to the check-out station and the service/products to be used by the guest correspond to the prepared order such that the debit system of the smart card allows deduction of an amount corresponding to the service/prepared order.).

In view of Suzuki, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Cupps/Miller to incorporate the feature of the check-out station deducting an amount corresponding to the prepared order identified by the assigned order number from an added-value card because it provides efficient and convenient personalized shopping assistance by allowing the customer not to carry any cash or additional printed receipts to authorize him to use the product/services already pre-paid for, as explicitly disclosed in Suzuki (col.3, lines 17-39).

Regarding claims 19-22, limitations are parallel to the limitations of claims 10-13 respectively and are therefore analyzed on the basis of same rationale.

5.4 Claims 14-15 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cupps/Miller as applied to claims 7 and 16 above, and further in view of Espada-Velasco (US Patent 5,802,890), hereinafter, referred to as Velasco.

Regarding claims 14, Cupps/Miller disclose an automatic cafeteria system as analyzed and disclosed in claim 7 above. Cupps/Miller as applied to claim 7 further does not disclose the following :

a basket for holding a prepared order, the basket having a sensor for detecting removal of a prepared order placed within the basket and generating an alarm in response to detection of such removal; and

the automated check-out station for deactivating the basket sensor so that the prepared order may be removed from the basket without generating the alarm in response to the detection of such removal.

However, Velasco discloses a basket for holding a prepared order, the basket having a sensor for detecting removal of a prepared order placed within the basket and generating an alarm in response to detection of such removal the automated check-out counter for deactivating the basket sensor so that the prepared order may be removed from the basket without generating the alarm in response to the detection of such removal (see at least col.1 lines 11-28, "*Several anti-theft devices are currently known which are applied to cases or containers which enclosure is designed to house the object to be protected snugly, the faces of the container including openings that allow access to said enclosure in order to enable the insertion and removal of the object to be contained. It is currently well-known to provide the inner container walls with **magnetic labels** at locations that are not accessible from the outside when the object or contents lie within the cavity or enclosure of said container, which labels are combined with known **anti-theft devices installed in the commercial establishments to trigger an acoustic alarm**. In order to prevent the dishonest removal of the object from its respective container.....* ". Note: Here, container corresponds to the basket, objects correspond to the prepared order, magnetic labels on container corresponds to sensors on the baskets, and the anti-theft devices installed in the establishments to trigger an acoustic alarm corresponds to the automated check station which can both trigger and deactivate the alarm. As indicated in Velasco, such devices and anti-theft alarms are well-known to a person of an ordinary skill in the art to prevent removal of objects from containers. Also it is also well-known in the art that if an alarm can be activated it can also be deactivated.).

In view of Velasco, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to modify Cupps/Miller as applied to claim

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7 to include the feature of a basket for holding a prepared order, the basket having a sensor for detecting removal of a prepared order placed within the basket and generating an alarm in response to detection of such removal and the automated check-out counter for deactivating the basket sensor so that the prepared order may be removed from the basket without generating the alarm in response to the detection of such removal for the obvious reason of preventing thefts and dishonest removals of objects from containers/baskets as explicitly taught in Velasco and at the same time if the packages are being picked up by the right person to allow them to pick up without activating the alarm.

Regarding claims 15, Cupps/Miller/Velasco disclose an automatic cafeteria system as analyzed and disclosed in claim 14 above. Cupps/Miller/Velasco as applied to claim further does not disclose the following :

- an anti-theft device coupled to the basket; and

- the system further comprising:

- a detector for detecting the unauthorized removal of the basket from the cafeteria so that the basket sensor has to be de-activated in order for the prepared order within the basket to be removed from the cafeteria without generating an alarm.

However, in the same field of endeavor of receiving food orders via communication network, Miller discloses an anti-theft device coupled to the basket and a detector for detecting the unauthorized removal of the basket from the cafeteria so that the basket sensor has to be de-activated in order for the prepared order within the basket to be removed from the cafeteria without generating an alarm. (see at least col.6, lines 61-65, which discloses that the prepared orders are kept in boxes with labels including alarm triggering sensors applied to them and these boxes with labels including

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alarm triggering sensors correspond to baskets with anti-theft device along with detection device for unauthorized removal of the baskets. Further, col.7, lines 46-51 also discloses that alarm triggering sensors have to be deactivated to enable the delivery men to pick up the delivery boxes).

In view of Miller, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to modify Cupps/Miller/Velasco as applied to claim 14 to include the feature of an anti-theft device coupled to the basket and a detector for detecting the unauthorized removal of the basket from the cafeteria so that the basket sensor has to be de-activated in order for the prepared order within the basket to be removed from the cafeteria without generating an alarm. Doing so would enable the system to prevent thefts or mix-ups and at the same time if the packages are being picked up by the right person to allow them to pick up without activating the alarm.

Regarding claims 23-24, limitations are parallel to the limitations of claims 14-15 respectively and are therefore analyzed on the basis of same rationale.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,598,790 to Horst discloses a self-service/automated check-out station allowing customers to perform their purchasing/making payment functions at this automated station and also at the same time with the capability to deactivate the security sensors attached to the products (see at least abstract).

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(ii) US Pub.No: 2001/0007450 A1 to Begum discloses that baskets/carts include an anti-theft alarm if they are removed from the premises an alarm will be generated (see at least page 2, paragraph 0015).

(iii) US Patent 5,317,304 to Choi discloses anti-theft device and alarm which includes a motion sensor and anti-tamper mechanisms for sounding an alarm when an apparatus is tampered with.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yogesh C Garg
Examiner
Art Unit 3625

YCG
February 19, 2004